

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 13-15, 17-19, 21-22 and 24 are rejected under 35 U.S.C. 103 over the patent to Petrone in view of the patent to Masahiro.

Claim 20 is rejected under 35 U.S.C. 103(a) over the patent to Hayden or Petrone in view of the patent to Brown.

At the same time claim 16 is not rejected over the art.

The Examiner's indication of the allowability of claim 16 has been gratefully acknowledged. In connection with this indication this claim has been canceled and a new claim 25 has been submitted which combines the features of the original claims 13 and 16. It is believed that claim 25 should be considered as being in allowable condition.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicants have amended claim 13 and

24, the independent claims currently on file, to more clearly define the present invention and to distinguish it from the prior art.

In his rejection of the claims the Examiner indicated that the application can be considered as obvious from the combination of the patents to Petrone and Masahiro.

It is respectfully submitted that it can not be considered as obvious to combine the teaching of the patent to Petrone and with the patent to Masahiro. These references are completely different. They deal with different objects, and a person of ordinary skill would not combine them as a matter of obviousness. No arguments have been presented why the combination of the references proposed by him can be considered as obvious.

It is believed to be advisable in connection with this to cite the decision in re Fritch, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992) in which it was stated:

"Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103 teaching of references can be combined only if there is some suggestion or incentive to do so."

It is believed that this decision is applicable for the present application. It can not be considered as obvious to combine the references in the manner suggested by the Examiner.

Even if for some unknown and highly improbable reasons, a person skilled in the art combine the teachings of the references, he would not arrive at the applicant's invention. The patent to Masahiro discloses a potentiometer, However the potentiometer which has the corresponding features designed and arranged in the inventive manner as defined in the claims can not be derived from a combination of the patents to Petrone and Masahiro. The arguments presented by the Examiner amount to unpermissible hindsight consideration, because the Examiner is familiar with the invention disclosed in the present application.

In connection with this it is advisable to cite the decision W. L. Gore & Assocs., Inc. V. Garlock, Inc., 220 USPQ 303, 312-13 (Fed. Cir. 1983), in which it was stated:

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is believed that this decision is applicable as well for the Examiner's approach to this application.

As for other references applied by the Examiner, these references do not come closer to the currently claimed subject matter than the above discussed references and therefore any detailed comments thereon would be superfluous.

Claim 13 and 24 have been additionally amended, and they now define that the potentiometer 25 is arranged in the housing 5 for determination of a position of the driven wheel 30, and the at least one projection 54 is provided on the housing 5 in which the potentiometer housing 47 is installed, to form a detent toothing 57 with the at least one detent tooth 51 of the potentiometer housing 47.

The patent to Petrone shows one housing, which is composed of a bottom part 2 and a top part 4. This references can not disclose a potentiometer nor can it make obvious a potentiometer housing, nor it teaches the feature that the potentiometer is arranged in a potentiometer

housing, which has at least one detent tooth which, together with at least one detent projection of the housing of the control drive forms a detent toothing.

It is important that in the applicant's invention the potentiometer housing is arranged in the housing of the control drive. This is not disclosed in the patent to Petrone since it deals only with the single housing, while the potentiometer is arranged on the plate.

The new feature of the present invention that the potentiometer housing is installed in the housing 5 of the control drive is shown in Figure 1 and disclosed in the specification, in particular in the paragraph bridging pages 3 and 4, where it is stated that:

"When potentiometer housing 47 is installed in the housing 5, the at least one detent tooth 51 and the at least one detent projection 54 form a detent toothing 47."

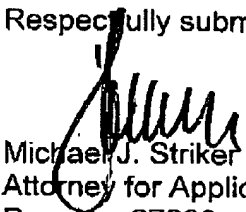
It is therefore believed to be clear that claims 13 and 24 should be considered as patentably distinguishing over the art should be allowed.


As for the dependent claims, these claims depend on claim 13, they share its allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,


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